

Remarks

35 U.S.C. §101 rejections

In the papers mailed August 16, 2011 claim 36, claim 37, claim 39, claim 40, claim 41, claim 42, claim 55, claim 56, claim 57, claim 58, claim 59 and claim 60 are rejected under 35 U.S.C. §101 because the number of undisclosed factors indicating that these claims do not represent statutory subject matter apparently exceeds the number of undisclosed factors that indicate the claims represent statutory subject matter. The Assignee traverses all 35 U.S.C. §101 rejections in several ways, including:

1) First, by noting that the assertions that the claims represent non statutory subject matter are not in compliance with the requirements of either standard of the Administrative Procedures Act and are therefore moot. For example, the author of the papers mailed August 16, 2011 has provided a vacuous statement to support the 35 U.S.C. §101 rejections that among other things is devoid of evidence. The claim rejections under 35 U.S.C. §101 are also arbitrary and capricious when given the fact that the U.S.P.T.O. issued a patent with a method claim for performing tasks associated with value based management (for example, see U.S. 7,899,732, claim 13) five months earlier.

2) Second, by noting that the arguments presented in the instant set of papers fail to establish a prima facie case of non statutory subject matter. In particular, the author has failed to explain why the transformation of a plurality of data into a plurality of predictive models does not comprise statutory subject matter for a method claim when calculating a plurality of financial ratios and comparing these ratios to those of another firm does constitute statutory subject matter for a method claim (for example, see U.S. 7,899,732, claim 13).

3) Third, by noting that there apparently is no statutory basis for the claim rejections as detailed by Link as amended.

35 U.S.C. § 103 rejections

In the papers mailed August 16, 2011 claim 36, claim 37, claim 39, claim 41, claim 42, claim 46, claim 47, claim 48, claim 55, claim 58, claim 59, claim 60, claim 76, claim 77, claim 78, claim 79, claim 80, claim 82, claim 83, claim 84, claim 85, claim 86, claim 88, claim 90, claim 91, claim 92, and claim 93 are rejected under 35 USC §103(a) as being unpatentable over Bielinski alone or in view of Baur. Claim 57 and 81 are rejected under 35 USC §103(a) as being unpatentable over Bielinski in view of Baur and Davis. Claim 40 is rejected under 35 USC §103(a) as being unpatentable over Bielinski in view of Baur and Bigus (6,192,354). Claim 50 is

rejected under 35 USC §103(a) as being unpatentable over Bielinski in view of Baur and Stork (5,245,696). Claim 38, claim 49, claim 50, claim 51, claim 52, claim 56, claim 78, claim 87 and claim 89 is rejected under 35 USC §103(a) as being unpatentable over Bielinski in view of Mauboussin. The Assignee traverses all §103(a) rejections in several ways, including:

1) First, by noting that the assertions regarding the alleged obviousness of the claims are not in compliance with the requirements of either standard of the Administrative Procedures Act and are therefore moot. Some of the reasons for this include:

a) All claim rejections are based on Bielinski which discloses value based management. One reason these rejections are arbitrary and capricious is that the U.S.P.T.O. issued two patents five months ago for "inventions" that complete processes that appear very similar to processes detailed in literature describing the practice of value based management (see Link as amended in August 2011). It is arbitrary and capricious to reject the instant application for alleged obviousness vis a vis value based management while issuing patents for later filed applications that describe processes first taught by value based management practitioners 20 years ago.

b) Another reason they are arbitrary and capricious is that they make it clear that there is a double standard that systematically favors large companies. Claim 40 in the instant application details a plurality of different types of predictive models that are used to develop a number of things including predictive models of the components of value. The claim is rejected on the basis of an IBM patent that discloses the adaptive selection and dispatch of an intelligent agent to complete a task. At the same time, IBM was not cited for double patenting during the "examination" of the IBM patents that mirror earlier filed Asset Reliance application and use a plurality of predictive models to develop new predictive models (see Link for specific examples).

2) Second, by noting that there apparently is no statutory basis for the claim rejections as detailed by Link as amended.

3) Third, by noting that the cited combination of documents fails to establish a prima facie case of obviousness. The papers mailed August 16, 2011 fail to establish the required prima facie case of obviousness in a number of ways, including: citing combinations of documents that teach away from the claimed invention, citing a combination of documents that fails to teach one or more limitation for every claim, failing to explain the combination as required by *KSR v Teleflex*, teaching a combination that requires a change in principle of operation of the disclosed inventions, citing documents that do not appear to be prior art documents and

teaching a combination that would destroy the ability of one or more of the inventions to function.

35 U.S.C. §112 first and second paragraph rejections

In the papers mailed August 16, 2011 claim 36, claim 37, claim 38, claim 39, claim 41 and claim 42 are rejected under 35 USC §112 first paragraph as the author of the papers claims that the specification does not describe an enterprise or elements of value that physically exist. In the papers mailed August 16, 2011 claim 36, claim 37, claim 38, claim 39, claim 41, claim 42, claim 46, claim 55 and claim 72 are rejected under 35 U.S.C. §112 second paragraph as the author of the papers claims that the specification does not describe an enterprise or elements of value that physically exist. The Assignee traverses all §112 first paragraph and second paragraph rejections related to the physical existence limitations in a number of ways, including:

- 1) The first way the Assignee will traverse all physical existence limitation rejections under 35 U.S.C. 112 is by noting that “there is no requirement that the words in the claim must match those used in the specification disclosure” and that the use of words in a claim that do not match those used in the specification does not comprise the incorporation of new matter (see In re Robert Skvorecz, CAFC 2008-1221).
- 2) The second way the Assignee will traverse all physical existence limitation rejections under 35 U.S.C. 112 is by noting that there apparently is no statutory basis for the claim rejections as noted in Link.
- 3) The third way the Assignee will traverse all physical existence limitation rejections under 35 U.S.C. 112 is by noting that the instant specification describes the creation of an integrated database for use in modeling and managing a business and its elements of value. As is well known in the art, businesses and their elements of value physically exist. It is well established that information which is well known in the art need not be described in detail in the specification. See, e.g., Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1379-80, 231 USPQ 81, 90 (Fed. Cir. 1986) and MPEP 2163.
- 4) The fourth way the Assignee will traverse all physical existence limitation rejections under 35 U.S.C. 112 is by noting that the claim rejections fail under both standards of the APA for the reasons outlined above.

The Assignee will also traverse the rejection of claim 36, claim 37, claim 38, claim 39 and claim 41 under 35 U.S.C. §112 first and second paragraph by noting that that these claims do not mention the term “physically exists”.

The Assignee will also traverse the rejection of claim 36, claim 37, claim 38, claim 39 and claim 41 under 35 U.S.C. §112 first paragraph by noting that the specification supporting these claims contains the same language found in co-pending application 09/688,983. The BPAI has already reviewed that language and found it meets the requirements of 112 first paragraph as detailed in the previously provided appeal decision and in the next section which provides information from co-pending applications.

Material from co-pending applications

Under the provisions of MPEP § 2001.06(b), the author of the set of papers mailed March 9, 2011 is hereby advised of information obtained from co-pending U.S. Patent Application(s) which may be "material to patentability" of the instant application (see *Armour & Co. v. Swift & Co.*, 466 F.2d 767, 779, 175 USPQ 70, 79 7th Cir. 1972).

The subject matter contained in the material incorporated herein above may be deemed to relate to the present application, and thus may be felt (with or without reasonable justification) to be material to the prosecution of the instant application.

- ☐ Copies of cited U.S. patent application(s) (office actions, specification, claims, and the drawings) or copies of the portion(s) of the application(s) which caused it(them) to be cited, including any claims directed to such portion(s) are attached hereto.
- ☒ Copies of the cited U.S. Patent Application(s) (office actions, specification, claims, and the drawings) and U.S. Patents are available on the U.S.P.T.O.'s Image File Wrapper. Therefore copies thereof need not be attached.
- ☐ The materials in the envelope are considered trade secrets and are being submitted for consideration under MPEP § 724.

Any and all of the listed co-pending applications are not to be construed as prior art. By bringing the above-listed information to the attention of the author, the Assignee does NOT waive any confidentiality concerning the above-listed co-pending application(s) or this application. See MPEP §101. Furthermore, if said application(s) should not mature into patents, such application(s) should be preserved in secrecy under the provisions of 35 U.S.C. § 122 and 37 C.F.R. § 1.14.

A comparison of an independent claim now pending in the instant application and the previously reviewed claims in co-pending application 09/688,983
<p>Instant application claim 36. (previously presented) An enterprise method, comprising:</p> <p>using a computer to complete at least one of the steps of:</p> <p>preparing data representative of an enterprise for processing,</p> <p><u>transforming at least a portion of the data into a linear or nonlinear model of an enterprise market value by a category of value by completing a plurality of multivariate analyses that utilize said data,</u> - see underlined portion of claim 163 from 09/688,983 below</p> <p><u>identifying a tangible value contribution of each of one or more elements of value to a value of each of the categories of value using said model of enterprise market value,</u> and - see underlined portion of claim 201 from 09/688,983 below</p> <p>outputting said tangible value contributions</p> <p>where the model of an enterprise market value by category of value comprises as many as three linear or nonlinear component of value models, an optional linear or nonlinear model of a market sentiment category of value and optionally one or more real option models and - see underlined portion of claim 204 from 09/688,983 below</p>
<p>09/688,983 claim 159. The computer readable medium of claim 157 wherein a market value further comprises one or more categories of value selected from the group consisting of an current operation, real option, market sentiment and combinations thereof.</p>
<p>09/688,983 claim 163. The computer readable medium of claim 157, wherein identifying and measuring a plurality of risks further comprises:</p> <p><u>developing a computational model of organization market value by category of value, element of value and external factor by completing a series of multivariate analyses in an automated fashion using at least a portion of the data,</u> and</p> <p>.... (portion of claim omitted for clarity)</p>
<p>09/688,983 claim 175. The system of claim 169, wherein identifying and measuring a plurality of risks further comprises:</p> <p>developing a computational model of organization market value by category of value, element of value and external factor by completing a series of multivariate analyses in an automated fashion using composite applications and at least a portion of the data, and</p> <p>quantifying a plurality of risks by a category of value using said model, where a category of value is selected from the group consisting of current operation, real option, market sentiment and combinations thereof. .</p>
<p>09/688,983 claim 176. The system of claim 175 wherein a series of multivariate analyses are selected from the group consisting of identifying one or more previously unknown item performance indicators, discovering one or more previously unknown value drivers, identifying one or more previously unknown relationships between one or more value drivers, identifying one or more previously unknown relationships between one or more elements of value, quantifying one or more inter-relationships between value drivers, quantifying one or more impacts between elements of value, developing one or more composite variables, developing one or more vectors, <u>developing one or more causal element impact summaries, identifying a</u></p>

best fit combination of predictive model algorithm** and element impact summaries for modeling enterprise market value and each of the components of value, building predictive models using transaction data, determining a net element of value impact for each category of value, determining a relative strength of the elements of value between two or more enterprises, developing one or more real option discount rates, calculating one or more real option values, calculating an enterprise market sentiment value by element, developing a covariance matrix, developing a series of scenarios, simulating a financial performance under a given scenario and combinations thereof.

09/688,983 claim 201. An advanced management method, comprising:
aggregating and preparing data from a plurality of enterprise related systems for use in processing, and
learning from at least a portion of the data as required to quantify a tangible impact for a plurality of risks and one or more elements of value on one or more subsets of value selected from the group consisting of a category of value, a component of value and combinations thereof

where one or more elements of value are selected from the group consisting of alliances, brands, customers, customer relationships, employees, employee relationships, infrastructure, intellectual property, information technology, partnerships, processes, production equipment, vendors, vendor relationships and combinations thereof, and
.... (portion of claim omitted for clarity)

204. The method of claim 201 wherein a category of value is selected from the group consisting of current operation, real option, market sentiment and combinations thereof and a component of value is selected from the group consisting of revenue, expense, capital and combinations thereof.

207. A management analysis method, comprising:
aggregating and preparing data from a plurality of enterprise related systems for use in processing, and
analyzing at least a portion of the data as required to quantify an enterprise value and risk by one or more subsets of value selected from the group consisting of a category of value, a component of value, an element of value and combinations thereof
where an element of value is selected from the group consisting of alliances, brands, customers, customer relationships, employees, employee relationships, infrastructure, intellectual property, information technology, partnerships, processes, production equipment, vendors, vendor relationships and combinations thereof;
where an enterprise value further comprises a market value, and.... (portion of claim omitted for clarity)

** Please note: the predictive model algorithms disclosed in the 09/688,983 specification include: neural network; classification and regression tree; generalized autoregressive conditional heteroskedasticity, projection pursuit regression; generalized additive model (GAM), redundant regression network; rough-set analysis, boosted Naïve Bayes Regression; multivariate adaptive regression spline; linear regression; support vector method and

stepwise regression

FIG. 6A, FIG. 6B and FIG. 6C from co-pending application 09/688,983 are incorporated herein to allow comparison with FIG. 6A, FIG. 6B and FIG. 6C of the instant application.

FIG. 6A

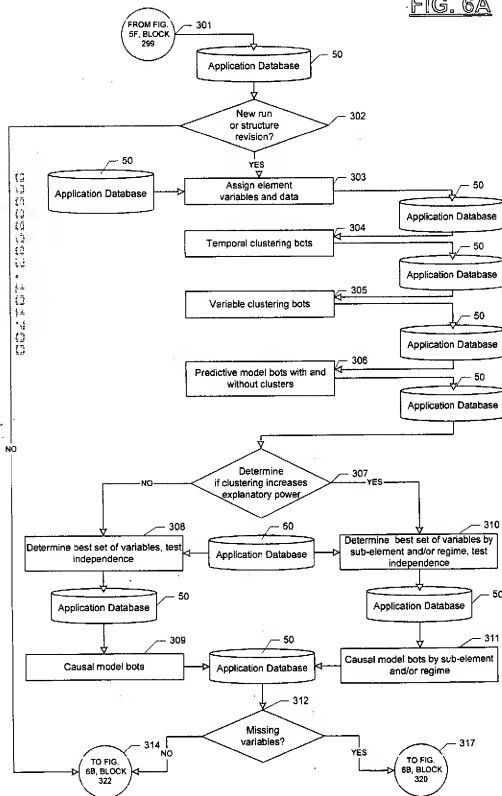


FIG. 6B

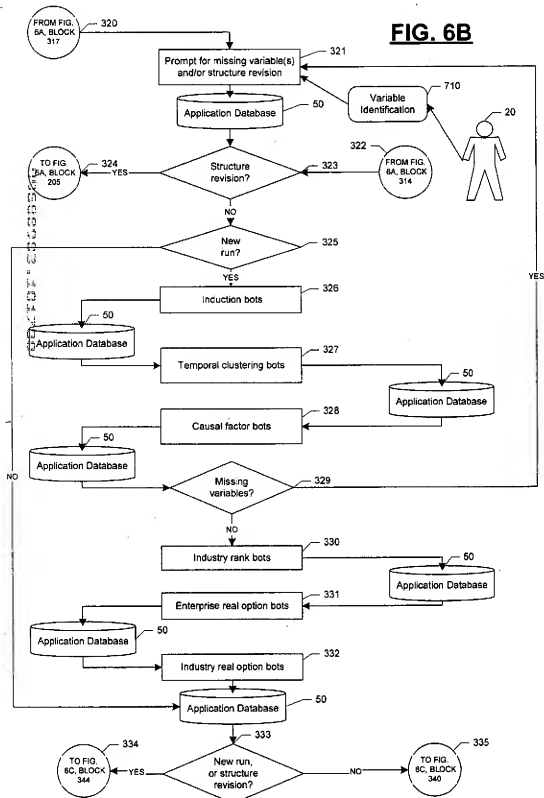
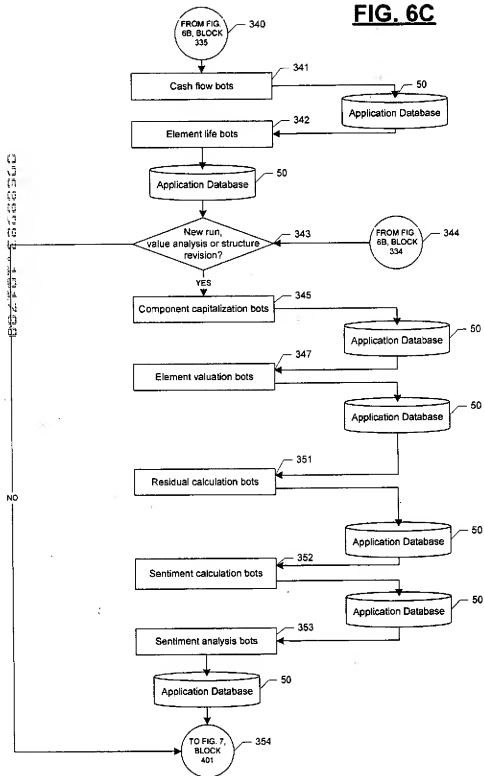


FIG. 6C



Reservation of rights

The Assignee hereby explicitly reserves the right to present the modified and/or canceled claims for re-examination in their original format. The cancellation or modification of pending claims to put the instant application in a final form for allowance and issue is not to be construed as a surrender of subject matters covered by the original claims before their cancellation or modification.

Conclusion

The pending claims are of a form and scope for allowance. Prompt notification thereof is respectfully requested.

Respectfully submitted,
Asset Trust, Inc.

/B.J. Bennett/

B.J. Bennett, President
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